

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVE	ATT	ORNEY DOCKET NO.	
09/454,68	4 12/03/	99 PROBST		P	210121.46904
-			\neg	EXAMINER	
		HM22/0705	'		
JANE E.R. POTTER			BRUNOVSKIS,P		
INTELLECT	UAL PROPER	TY LAW GROUP PLLC		ART UNIT	PAPER NUMBER
6300 COLL	MBIA CENTE	R			•
701 FIFTH	I AVENUE			1632	16
SEATTLE W	JA 98104-70	92		DATE MAILED:	()
					07/05/oì

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

	Application No.	A				
<i>,</i>	Application No.	Applicant(s)				
. Office Action Summary	09/454,684	PROBST ET AL.				
, one Action Cammary	Examiner	Art Unit				
	Peter Brunovskis	1632				
The MAILING DATE of this communication appe Period for Reply	ars on the cover sheet with the co	rrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period w Failure to reply within the set or extended period for reply will, by statute, - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). Status	i6 (a). In no event, however, may a reply be tin within the statutory minimum of thirty (30) days ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. O (35 U.S.C. § 133).				
1) Responsive to communication(s) filed on	<u> </u>					
2a) ☐ This action is FINAL . 2b) ☑ Thi	s action is non-final.					
Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4) Claim(s) 1-66 is/are pending in the application						
4a) Of the above claim(s) is/are withdraw	vn from consideration.					
5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8)⊠ Claims <u>1-66</u> are subject to restriction and/or e	lection requirement.					
Application Papers						
9) The specification is objected to by the Examine	er.					
10) The drawing(s) filed on is/are objected to by the Examiner.						
11) The proposed drawing correction filed on is: a) approved b) disapproved.						
12) The oath or declaration is objected to by the Ex	kaminer.					
Priority under 35 U.S.C. § 119						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
14) Acknowledgement is made of a claim for dome	·					
TAIL ACKNOWLEDGEMENT IS MADE OF A CIAIM TO DOME	Sale priority under 33 0.0.0. § 11	J(U).				
Attachment(s)						
 15) Notice of References Cited (PTO-892) 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 	19) 🔲 Notice of Informal	ry (PTO-413) Paper No(s) Patent Application (PTO-152)				

Application/Control Number: 09/454,684 Page 2

Art Unit: 1632

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1, 2, 7-10, 13, 15, 17(a), 18, 20, 22(a), 23-25, and 64-66, drawn to
 polypeptides and methods of using such, classified in class 530, subclass 350.
- II. Claims 3-6, 11, 14, 16, 17(b), 19, 21, 22(b), 23-25, drawn to polynucleotides, classified in class 536, subclass 23.7.
- III. Claims 12, 17(c), 22(c), 23-25, 26, drawn to antibodies, classified in class 530, subclass 387.1.
- IV. Claims 27-29, 39-44, and 49, drawn to a diagnostic method wherein the binding agent is a protein, classified in class 435, subclass 7.1.
- V. Claims 30, 31, 45, and 46, drawn to primers and their use in a diagnostic PCR assay, classified in class 435, subclass 91.2.
- VI. Claims 32, 33, 47, and 48, drawn to oligonucleotide probe(s) and their use in a diagnostic hybridization assay, classified in class 435, subclass 6.
- VII. Claims 34-38 and 49, drawn to a diagnostic method wherein the binding agent is an antibody, classified in class 435, subclass 7.1.
- VIII. Claims 50, 52-57, drawn to a pharmaceutical cell composition comprising T cells proliferated in the presence of a polypeptide and ex vivo administration of said

Art Unit: 1632

cells in a method of treating Chlamydial infection, classified in class 424, subclass 93.21.

- IX. Claim 51-55, and 58, drawn to a pharmaceutical cell composition comprising T cells proliferated in the presence of a polynucleotide and ex vivo administration of said cells in a method of treating Chlamydial infection, classified in class 424, subclass 93.21.
- X. Claims 59, 61, and 62, drawn to a method of treating Chlamydial infection, comprising ex vivo administration of antigen-presenting cells incubated in the presence of a polypeptide, classified in class 424, subclass 93.21.
- XI. Claims 60, 61, and 62, drawn to a method of treating Chlamydial infection, comprising ex vivo administration of antigen-presenting cells incubated in the presence of a polynucleotide, classified in class 424, subclass 93.21.

For purposes of restriction, claim 46 is interpreted as depending from claim 45, since there is a lack of antecedent basis relative to claim 43, as recited.

Generic claims 17, 19, 22, 23-26, 52-55, and 59-62 are improperly drawn to multiple dependent claims. MPEP 608.01 (n), part I.C. states:

"For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim".

Application/Control Number: 09/454,684

Art Unit: 1632

Inventions I-XI are each drawn to multiple, patentably distinct sets of inventions, drawn or directed to the use in each case to a separate, patentably distinct polypeptide, polynucleotide, or antibody. The separate members of each independent and distinct polypeptide, polynucleotide, or antibody are not proper species of a genus, since there are no common core structures among members of each generic polypeptide-, polynucleotide or antibody group. Consequently, Applicant is required under 35 U.S.C. 121 to elect a single disclosed SEQ ID NO for prosecution on the merits to which the claims shall be restricted.

Page 4

Applicant is advised that a reply to this requirement must include an identification of the SEQ ID NO that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. If claims are added after the election, applicant must indicate which are readable upon the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Product inventions of groups I-III, and VIII-XI and method inventions of groups IV-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or comprise different products with different functions and different modes of operation functioning in mechanistically different ways. Inventions I-XI are distinct because the inventions utilize biologically distinct reagents and function in mechanistically different ways. Methods of utilizing independent

Application/Control Number: 09/454,684

Art Unit: 1632

patentably distinct polypeptides, polynucleotides, oligonucleotides, antibodies, or cells of the instant invention for therapeutic and/or diagnostic purposes requires different technical considerations, objectives, and modes of action. The differences between Inventions I-VII and inventions VIII-XI are further underscored by their different classification and independent search status.

Page 5

Invention I and inventions IV, VIII, and X; invention II and inventions V, VI, IX, and XI; and invention III and invention VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of inventions I can be used to make the antibodies of invention III; the polynucleotides of invention III can be used to make the polypeptide of invention I; and the antibody of invention III can be used to immunopurify the polypeptide of invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Groups II-XI, and vice versa, restriction for examination purposes as indicated is proper.

Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Brunovskis whose telephone number is (703) 305-2471. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda can be reached at (703) 305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to the Patent Analyst, Patsy Zimmerman whose telephone number is (703) 308-8338.

Peter Brunovskis, Ph.D. Patent Examiner Art Unit 1632

SCOTT D. PRIEBE, PH.D PRIMARY EXAMINER

Scott D. Pruhe